

REMARKS

Instant claims 1-7, and 10-15 stand pending in the instant Application. The instant claims 10-14 are withdrawn by the Examiner. No new matter is added by the present amendment.

Support for new claims 16 and 17 may be found, for example, in the initial initiator quantities provided in Examples 1 and 2, respectively, in the instant specification at page 17 (7th line of Example 1), and page 18 (2nd line of Example 2). That is, 0.78 g of initiator, APS, in the kettle initially is 0.08% when expressed as a percentage of the total monomer charge of 1001.25 g, as in the amended claim 16; and 0.3 g of initiator, APS, in the kettle initially is 0.03% when expressed as a percentage of the total monomer charge of 1001.25 g, as in the amended claim 17.

Personal Interview with the Examiner

Applicants' attorney thanks Examiner Ronesi for extending the courtesy of a personal interview on 15 October 2007, in which applicants' representatives presented data comparing polymers prepared *via* the inventive process and *via* the cited prior art process. The Interview Summary accurately states: "Applicant's representatives presented convincing data showing a difference by adding initiator and neutralizer by the claimed process in the product-by-process."

The parties also discussed how to accord data and claim language commensurate in scope with one another.

The interview date is incorrectly labeled as 15 August on the Interview Summary.

The Applicants wish to thank Examiner Ronesi for extending the courtesy of a personal interview.

Claim Rejections: 35 U.S.C. §102/ 103

Claims 2-5 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Friel et al. (U.S. 5,731,377), hereafter "Friel".

The rejection has cited case law to the effect that "even though the product-by-process claims are limited by and defined by the process, determination of patentability is

based on the product itself'. However, the record admits that the data in the Rule 132 Declaration of Ralph Even, filed concurrently herewith, shows that the product-by-process of the invention as represented by claim 2 results in a different product from that of the cited art of Friel. See the discussion of the 35 USC 103(a) rejections, below.

Because a proper anticipation rejection requires evidence that the product produced in Friel is the same as the product produced by the instantly recited process, and has failed to do this, the §102(b) rejections of instant claims 2-5 and 7 are, therefore, improper and should be withdrawn.

Claim Rejections: 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as obvious over Friel, of record. Claims 1 and 3-7 stand rejected under 35 U.S.C. §103(a) as obvious over Friel in view of Ishikawa (US 4,325,856), hereafter "Ishikawa". Claim 15 stands rejected under 35 U.S.C. §103(a) as obvious over Friel in view of Ishikawa (US 4,325,856), and further in view of Bricker (US 5,502,089) hereafter "Bricker". The rejection states that the final products appear to be the same, and that it would have been obvious to one of ordinary skill in the art to obtain the presently claimed product with a different process.

In addition to applicants' original data of Example 4 (Table 4.1, page 20 of the specification) showing unexpected results, Applicants have included herewith a Declaration of Ralph Craig Even, under Rule 132, dated 21 Dec 2007, directly comparing compositions made according to the art of Friel with compositions made according to the instantly recited product by process having the same starting material as the starting material in Example 3 of Friel. The Even Declaration also addresses the full scope of the instant claims and provides the process details for the polymers in the newly presented data. See declaration of Ralph Craig Even of 21 Dec 2007, paragraph 6 and Table 1.

Based on the Even Declaration, the Applicants have established the criticality of the instantly recited product made by the instantly recited process in making a different product *and* have shown this criticality with data. The applicants' Comparative Examples A, B, C and D represent, respectively, the same monomer composition (levels of monomer and Tg) as each of Examples 1 and 2. See the instant specification at page 17, line 6, to page 19, line 9. Likewise, the Applicants' Comparative Examples E and F

represent, respectively, the same monomer composition (levels of monomer and Tg) as each of Examples 5 and 6. See the instant specification at page 20, line 20, to page 21, line 12.

Further, the Examples in the instant specification both show that the instantly recited composition made by the instantly recited process gives a product having from 10% (Ex. 1 v. Comparative Ex. A) to 45% (Ex. 2 v. Comparative Ex. C) better scrub resistance, i.e. it gives a different product. See Table 4.1 on page 20 of the instant specification. As a product and its properties are inseparable, so the instantly recited product differs from that of Friel.

The new grounds of rejection regarding Ishikawa were brought to establish that the teachings of Ishikawa may render at least claim 1 obvious in the event that the only difference in the product-by-process of claim 1 was the use of a chain transfer agent. However, since this rejection was brought, applicants have presented the Even Declaration, discussed above, showing that the product-by-process in the claim differs from the product in Friel, even if one allows the additional use of chain transfer agent (please see Declaration, paragraph 9). Thus, whether or not Ishikawa teaches the use of a chain transfer agent, the combination of Ishikawa and Friel, or Friel alone, does not render the invention of either claim 1 or claim 2 obvious.

Accordingly, the Applicants' showing of a different and improved product resulting from the use of the inventive process compared to the process of Friel is sufficient to support patentability. In a separate action, the comparison in the Examples of the instant specification was held sufficient in the European Patent Office, where this application has already passed to allowance.

Thus, the product resulting from the inventive process is not obvious with respect to Friel, or, in the case of claim 1, with respect to Friel in view of Ishikawa. The §103(a) rejections should be withdrawn.

Regarding claim interpretation, the lower limit of initiator concentration in instant claims 1-7, and any potential scope of the showing in the Even Declaration, please be advised that the instantly recited phrase "conversion of monomers to said emulsion polymer" indicates a non-zero level of initiator, because the ordinary skilled artisan understands that polymerization will not proceed to 10% conversion without initiator.

The same argument is applicable to the language of claim 2 ("the conversion of monomers to said emulsion polymer"). Given that non-zero levels of initiator are necessarily implied, and that the invention is based on introducing more initiator late in the polymerization, the instant claims 1-7 and 10-14 should be interpreted as having an initially low level of initiator during the first 10% of the polymerization.

New claims 16 and 17:

Regarding new claims 16 and 17, Friel fails to disclose, teach or suggest any of the products obtained by the instantly recited product by process. And there is no suggestion or motivation in Friel to alter the processes disclosed therein in a manner that would produce the processes of claims 16 and 17. Accordingly, instant claims 16 and 17 are allowable over Friel, either alone, or taken in combination with any of the other references cited.

Reconsideration of Restriction Requirement and Request for Rejoinder:

Claims 10-14 were withdrawn from consideration by the Examiner as being directed to a process of making the composition of instant claims 1-7. However, a composition and the method of making the same are considered to be one and the same invention. See *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995). Applicants have insured that instant Claim 10 includes all of the limitations of instant Claim 2. Accordingly, Applicants hereby respectfully request the rejoinder of Group I, claims 1-7, and Group II, claims 10-14 upon an indication of the allowability of the instant composition claims. See MPEP 8.21.04, 1st two paragraphs.

The applicants hereby also request rejoinder of instant claims 10-14.

CONCLUSION

Based on the foregoing, the instant claims are believed to be in condition for allowance. Applicants' attorney thanks the Examiner for the time taken to review this response and Declaration.

Respectfully submitted,



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